

REMARKS

Claims 1, 3-7, 11, 12 and 18-29 were pending in this application.

Claims 1, 3-7, 11, 12 and 18-29 have been rejected.

Claims 11, 21-23 and 26 have been amended.

Claims 1, 3-7, 11, 12, and 18-29 remain pending in this application.

Reconsideration and full allowance of Claims 1, 3-7, 11, 12, and 18-29 are respectfully requested.

I. OBJECTION TO OATH/DECLARATION

The Office Action objects to the oath or declaration as failing to comply with 37 C.F.R. § 1.61 (now § 1.63). Section 1.63 requires the declaration to state that the person making the declaration to acknowledge his duty to disclose all information known to him to be material to patentability as defined in § 1.56. The declaration as filed by the Applicant acknowledges the inventor's duty to disclose under § 1.56(a).

The Applicant notes that subsection § 1.56(a) states that “[e]ach individual associated with the filing and prosecution of a patent application has...a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.” Subsections (b) and (c) define “materiality” and “individuals associated with the filing or prosecution of a patent application.” Subsection (d) describes how an individual other than an inventor may comply with the section and subsection (e) describes the duty in a continuation in part application. Thus, the Applicant respectfully submits that the inventor’s duty to disclose “as

defined in § 1.56” arises under § 1.56(a), and therefore the declaration’s acknowledgement of duty under § 1.56(a) fulfills the requirement of § 1.63 that the declaration acknowledge the duty to disclose all information known to him to be material to patentability as defined in § 1.56. The Applicant respectfully requests withdrawal of the objection.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 21-25 and 29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,198,479 to Humpleman et al. (“*Humpleman*”). The Applicant respectfully traverses this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (*Fed. Cir.* 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (*Fed. Cir.* 1985)).

As amended, Claim 21 recites a method, comprising “storing in a server codes for graphically representing on a graphic user interface of a remote control device one or more controllable features of a plurality of devices.” In contrast, *Humpleman* describes a home network of devices that each stores one or more HTML files defining control and command functions associated with the device. *Humpleman*, col. 6, lines 40-50. The HTML files enable

each device in the home network to send a customized graphical user interface to a browser based digital TV for display to a user. *Humpleman*, col. 6, lines 57-62.

Where the *Humpleman* reference teaches individual devices that each provides a file describing a customized control interface, Claim 21 recites a server storing codes for graphically representing controllable features of a plurality of devices. Claims 22-25 and 29 depend from Claim 21 and contain all the limitations of their base claim. Thus, the *Humpleman* reference fails to show each and every limitation of the claimed invention as recited in Claims 21-25 and 29.

For these reasons, *Humpleman* fails to anticipate the Applicant's invention as recited in amended Claims 21-25 and 29. Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 21-25 and 29.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 3-7, 18 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over *Humpleman* in view of U.S. Patent No. 6,049,671 to Slivka, et al. ("Slivka").

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-133 (8th ed. rev. 3 August 2005). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

The *Humpleman* reference describes a home network of devices that each stores one or more HTML files defining control and command functions associated with the device. *Humpleman, col. 6, lines 40-50.* The HTML files enable each device in the home network to send a customized graphical user interface to a browser-based digital TV for display to a user. *Humpleman, col. 6, lines 57-62.* Each device in the home network described in *Humpleman* provides such an HTML file, thus every device in the home network may be controlled by the browser. *Humpleman, col. 4, lines 12-48.* The *Slivka* reference describes a system for automatically identifying software for installation on a computer and for making the software available to the computer. *Slivka, col. 1, lines 11-14.* The software for installation may be updates to software already installed on the computer or newly available software. *Slivka, col. 2, lines 44-49.*

With reference to Claim 1, the Office Action asserts that the *Humpleman* reference describes the recited limitation “enabling a determination of at least one appliance for being user-controlled through the control device” at column 2, lines 34-38. The cited passage describes a method including the step of:

connecting a client device to the home network, wherein the device is capable of displaying a user interface; executing a software agent on the client device, wherein executing the software agent causes a user interface to be displayed on the client device.

The Applicant respectfully submits that *Humpleman* teaches no determination of a device for being user-controlled. Instead, the reference describes a home network of devices, “wherein the device is capable of displaying a user interface.” There are no devices in the *Humpleman* network that are not capable of “being user-controlled through the control device” as recited in Claim 1. Moreover, the description in *Slivka* of a system for updating or installing new software fails to overcome this shortcoming of *Humpleman*. Thus, the suggested combination of the *Humpleman* and *Slivka* references fails to teach or suggest all the claim limitations.

The Office Action also fails to establish a motivation to combine the teachings of the *Humpleman* and *Slivka* references. The *Slivka* reference describes a system for updating a general purpose computer whose functionality may be changed by the installation of new software and whose current functionality may be improved by the installation of new versions of current software. In contrast, *Humpleman* describes a network of appliances of fixed functionality, each with a built-in file defining a graphical user interface adapted to that fixed functionality. There is no teaching in *Humpleman* of changes to the user interface or of the possibility of changing the functionality of the appliances. Therefore, the motivation to combine

the *Humpleman* and *Slivka* references cited by the Office Action—to increase the flexibility of use and to maintain the most up to date information—comes from the applicant's disclosure, rather than from the references themselves or the knowledge generally available to one of ordinary skill in the art.

Furthermore, there is no reasonable expectation of success in the combination of the *Humpleman* and *Slivka* references cited by the Office Action. The *Humpleman* reference describes loading from an appliance a file describing a graphical user interface for that very appliance. The *Slivka* reference describes loading from a network device to a general purpose computer new and updated software for that very computer. There is no teaching in either reference of loading from a network device to a browser device a graphical user interface file for control of a third device in communication with the browser device. The expectation of success in such a modification of the home network of *Humpleman* by the computer software update system of *Slivka* comes not from the references themselves, but rather from the applicant's disclosure.

Finally, in a second way the suggested combination of the *Humpleman* and *Slivka* references fails to teach or suggest all the claim limitations. Applying the teaching of the software update system of *Slivka* to the home network browser of *Humpleman* results in a home network browser that communicates with an Internet site to discover update to the software of the browser device and new software to execute on the browser device. The combination does not result in a method of determining code for representing on a graphical user interface a controllable feature of an appliance by accessing an Internet site, as recited in Claim 1.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 3-7 and 18. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1, 3-7, 18 and 26-28.

With reference to Claim 26, the amended claim recites a method, comprising “providing to a server an identification of at least one device, the device being one of a plurality of devices having codes stored in the server for graphically representing on a graphic user interface of a remote control device one or more controllable features of the device.” In contrast, *Humpleman* describes a home network of devices that each stores one or more HTML files defining control and command functions associated with the device. *Humpleman, col. 6, lines 40-50.*

Where the *Humpleman* reference teaches individual devices that each provides a file describing a customized control interface, Claim 26 recites providing an identification of one device among a plurality of devices with codes stored in a server for graphically representing controllable features of the devices. The *Slivka* reference does nothing to overcome this shortcoming of the *Humpleman* reference. Claims 27 and 28 depend from Claim 26 and contain all the limitations of their base claim. Thus, the suggested combination of the *Humpleman* and *Slivka* references fails to teach or suggest all the claim limitations as recited in Claims 26-28.

Furthermore, as argued with reference to Claim 1, the Office Action fails to establish a motivation to combine the teachings of the *Humpleman* and *Slivka* references. There is no teaching in *Humpleman* of changes to the user interface or of the possibility of changing the functionality of the appliances. Therefore, the motivation to combine the *Humpleman* and *Slivka*

references cited by the Office Action—to increase the flexibility of use and to maintain the most up to date information—comes from the applicant's disclosure, rather than from the references themselves or the knowledge generally available to one of ordinary skill in the art.

Also, as argued with reference to Claim 1, there is no reasonable expectation of success in the combination of the *Humpleman* and *Slivka* references cited by the Office Action. There is no teaching in either reference of loading from a network device to a browser device a graphical user interface file for control of a third device in communication with the browser device. The expectation of success in such a modification of the home network of *Humpleman* by the computer software update system of *Slivka* comes not from the references themselves, but rather from the applicant's disclosure.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 26-28. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 26-28.

The Office Action rejects Claims 11, 12, 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Slivka* in view of *Humpleman*.

The Office Action asserts that in describing a computer receiving updated browser software, the *Slivka* reference teaches receiving user interface code from an Internet site. As amended, Claim 11 recites receiving “user interface code from an Internet site storing interface codes for a plurality of electronic devices.” In contrast, *Slivka* describes updating browser software in only a single device: the computer running the browser program. Also in contrast to

the limitations of Claim 11, the *Humpleman* reference describes receiving an HTML file defining control and command functions associated with a device from the device itself, not from a separate device storing HTML files for a plurality of devices. Thus, the suggested combination of the *Humpleman* and *Slivka* references fails to teach or suggest all the claim limitations.

Furthermore, there is no motivation to combine the teachings of the *Slivka* and *Humpleman* references. The motivation asserted in Office Action—to allow any browser based appliance to control the electronic devices of the *Humpleman* network—is already present in *Humpleman*. Each electronic device is already capable of providing an HTML file defining control and command functions to any browser based appliance requesting the file. No modification of the teaching of the *Humpleman* reference is needed.

Similarly, there is no reasonable expectation of success in the combination of the *Slivka* and *Humpleman* references cited by the Office Action. There is no teaching in either reference of loading from a network device to a browser device a graphical user interface file for control of a third device in communication with the browser device. As such, both the teaching or suggestion to make the claimed combination and the reasonable expectation of success are found in the applicant's disclosure, rather than in the prior art.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 11, 12, 19 and 20. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 11, 12, 19 and 20.

**DOCKET NO. A 023501
SERIAL NO. 09/311,128
PATENT**

V. CONCLUSION

The Applicant respectfully asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

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SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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